

### **RESPONSE AND REMARKS**

The Office Action was organized by numbered topics. Responsive remarks herein refer to the Office Action Topic Numbers, or provide a citation in the format: "Office Action, Topic No. #, p. #."

#### **SECTION 102(e) REJECTIONS**

In the Office Action, Claims 12 and 30 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kara et al. (PCT Publication No. WO 99/21330, "Kara II"). Office Action, Topic Nos. 2-3, pgs. 3-4.

In the Office Action, Claims 27 and 50 were rejected under 35 U.S.C. § 102(e) as being anticipated by Kara et al., (U.S. Patent No. 6,233,568; "Kara"). Office Action, Topic Nos. 4-7, pgs. 4-6.

In the Office Action, Claims 44 and 45 were rejected under 35 U.S.C. § 102(e) as being anticipated by Nicholls (U.S. Patent No. 5,485,369, "Nicholls"). Office Action, Topic Nos. 8-10, pgs. 6-7.

#### **SECTION 103(a) REJECTIONS**

In the Office Action, Claims 29, 31 and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nicholls in view of Kara. Office Action, Topic Nos. 13-15, pgs. 8-9.

In the Office Action, Claims 29, 31, and 49 were expressly rejected under 35 U.S.C. § 103(a) as being unpatentable over Nicholls in view of Kara and InterShipper (Newsbytes Article, Internet Update, "InterShipper"). Office Action, Topic No. 16, pg. 9.

Subsequent to the rejection in Topic No. 16 of Claims 29, 31, and 49, the Office Action discusses Claims 33, 34, 35 and 42 with respect to Nicholls. See Office Action, Topic Nos. 17-18, pgs. 9-10. Subsequently, the Kara and InterShipper references are discussed. However, it is unclear in the subsequent discussions whether the Office Action is specifically addressing the limitations of Claims 33, 34, 35 and 42, or whether the Office Action is addressing the rejection of Claims 29, 31 and 49.

The Office Action included independent Claims 33, 34, 35 and 42 in the list on the Office Action cover page as having been rejected. However, the Office Action does not expressly state grounds for the rejection of independent Claims 33, 34, 35 and 42. The Office Action discusses the Nicholls reference with respect to independent Claims 33, 34, 35 and 42. See Office Action, Topic No. 17, p. 9. Subsequent to the discussion of Nicholls with respect to independent Claims 33, 34, 35, and 42, the Office Action discusses the Kara and InterShipper references. See Office Action, Topic Nos. 18-19, pgs. 9-10. For purposes of this Response, the discussion in the Office Action concerning the Kara and InterShipper references subsequent to the discussion of Nicholls with respect to independent Claims 33, 34, 35, and 42, is taken to mean that Claims 33, 34, 35 and 42 were rejected under Section 103(a) as being unpatentable over Nicholls in view of Kara and InterShipper.

Subsequent to the rejection of Claims 29, 31, and 49, the Office Action discusses Nicholls with respect to Claim 49 (Office Action, Topic No. 20, pgs. 10-11) and then discusses the Kara and InterShipper references (Office Action, Topic Nos. 21-22, pgs. 11-12).

Subsequent to the rejection of Claims 29, 31 and 49, the Office Action discusses Nicholls with respect to Claim 36 (Office Action, Topic No. 23, p. 12) and then discusses the Kara and InterShipper references (Office Action, Topic Nos. 24-26, pgs. 12-13). The Office Action also mentions a reference identified in the Office Action only as "Fisher." Office Action, Topic Nos. 24-26, pgs. 12-13. In a previous Office Action, a reference named "Fisher" was identified as U.S. Patent No. 6,047,264 ("Fisher"). The reference in the present Office Action to "Fisher" is taken to refer, therefore, to U.S. Patent No. 6,047,264. For purposes of this Response, the discussion in the Office Action concerning the Kara, InterShipper, and Fisher references subsequent to the discussion of Nicholls with respect to independent Claim 36, is taken to mean that Claim 36 was rejected under Section 103(a) as being unpatentable over Nicholls in view of Kara, InterShipper, and Fisher.

**RESPONSE TO REJECTIONS UNDER SECTIONS 102(e) AND 103(a)**

The rejections of the Claims have been carefully considered. Independent Claim 29 was cancelled as part of the Appeal Brief previously filed. Claims 1-3, 9, 17, 20-21, 24, 26, 32, 37-41, 46-48, and 53 were previously cancelled. Previously withdrawn Claims 4-8, 10-11, 13-16, 18-19, 22-23, 25, 28, 43, and 51-52 and Claim 31 are cancelled herewith. Claims 12, 27, 30, 36, 44, 45 and 50 have been amended to more distinctly claim the claimed invention; new dependent Claims 54-57 have been added. A Declaration by William W. Smith III Filed In Support of Amendment and Response to Office Action Dated March 6, 2008 (the “*Smith Decl’n*”) is filed concurrently in support of this response.

**With Regard to Claims 12 and 30, The Characterizations By the Office Action of Kara II Fail to Fully Reflect all of the Limitations of Claims 12 and 30 and There is No Disclosure in Kara II of a Recipient Providing Destination Address Information or of the Kara II System Collecting Destination Address Information from a Recipient**

For the reasons explained below, it is respectfully asserted that the rejections by the Office Action of Claims 12 and 30 reflect a perception of what is today commonplace, not a view of the recited functional limitations from the perspective of someone with ordinary skill in the art at the time the invention was made. Consequently, as compared to the requirements for an obviousness rejection under 35 U.S.C. Section 103(a), as those requirements are explained in MPEP §§706.02(j) and MPEP §2143, it is respectfully asserted that the rejections fail to cite support for any disclosure, anticipation, teaching or suggestion by any reference or combination of reference of record for each of the limitations recited by Claims 12 and 30. In particular, as further explained below, it is respectfully asserted that the characterizations by the Office Action of the Kara II reference fail to fully reflect all of the limitations of Claims 12 and 30 and further, that there is no disclosure in Kara II of the claimed limitations of a recipient providing destination address information or of the Kara II system collecting destination address information from a shipping recipient.

In rejecting Claims 12 and 30, the Office Action posits that Kara II discloses, among other things, “[c]ollecting from a user, parcel specifications ... shipping preferences for a particular parcel ... the parcel specification includes an origin address (Kara discloses the use of delivery address, return addresses, which the examiner considers to be an origin address, ... and a parcel type, ....” Office Action, Topic No. 3.b, p. 3.

In rejecting Claims 12 and 30, the Office Action further posits that Kara II discloses, among other things:

Collecting, from a second user, destination address which includes a zip code (Kara discloses providing a delivery service with information as to how the documents should be delivered, and delivery preferences, which includes service as well as address (Page 14, lines 13-28, the recipient discloses whether the mail is sent via physical mail, or electronic mail, therefore different carriers, and that information would include which carrier would deliver the mail (see abstract)....

Office Action, Topic No. 3.c, pgs. 3-4.

The Office Action further asserts that “[w]here the information is being obtained, whether it is from a first user, third user or second user, it is still collecting the information from an outside source, then processing the information the same way. Therefore the limitation of collecting a request from a ‘second user’ is not considered to be a functional limitation, due to the fact that the software would run the same regardless of if the request was coming from a first user or a second user.” Office Action, Topic No. 28, p. 14.

For the following reasons and authorities, Applicant(s) respectfully assert that the above-cited characterizations by the Office Action of Kara II do not fully reflect all of the limitations of Claims 12 and 30 regarding collecting and using input from multiple users in view of the amendments to those Claims, and respectfully request that Claims 12 and 30 be reconsidered and allowed.

It is respectfully asserted that the Office Action’s above-cited characterizations of Kara II merely show input by a first user and input by a second user. As distinguished from the Office Action’s above-cited characterizations of Kara II, amended Claim 12, for example, recites:

... collecting from a second user, a request that a first user ship a

particular parcel to a destination to be designated by the second user;

...

To ascertain the meaning of the terms "second user," and "first user," as those terms are used in independent Claims 12 and 30, it respectfully asserted that it is proper to consider the claims and the Specification of the present patent application. See, e.g., *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979, 34 U.S.P.Q.2D (BNA) 1321, 1329 (Fed. Cir. 1995) (*in banc*), *aff'd*, 517 U.S. 370 (1996) ("To ascertain the meaning of claims, we consider three sources: The claims, the specification, and the prosecution history." (citations omitted)).

It is respectfully asserted that, in view of the language of independent Claim 12, the claimed second user is properly interpreted to be a buyer, a buying user, a recipient, someone representing a buyer, or a recipient, or some other party requesting that a first user ship an item to a destination indicated by the second user. In particular, Claim 12 recites that "... a request [by a second user] that a first user ship a particular parcel to a destination to be designated by the second user." Other language of Claim 12 further supports that the claimed second user is properly interpreted to be a buyer, a buying user, a recipient, someone representing a buyer or a recipient, or some other party requesting that a first user ship an item to a destination indicated by the second user. In particular, Claim 12 further recites:

... collecting, from the second user via a second set of interactive accesses to the shipping management computer system by a second computer device, a set of recipient information corresponding to the request comprising: (A) a destination address to which the particular parcel is to be shipped by the first user, (B) an identification of a carrier to be used in shipping the package to the destination address, and (C) a delivery service by which the carrier is to ship the package to the destination address ...

Further, it is respectfully asserted that, in view of the language of independent Claim 12, the claimed first user is properly interpreted to be a shipper, a shipping user, a sending user, or someone representing a shipper, shipping user or sending user. In particular, Claim 12 recites that "... a first user ship a particular parcel to a destination to be designated by the second user."

Other language of Claim 12 further supports that the claimed first user is properly interpreted to be a shipper, a shipping user, a sending user, or someone representing a shipper, shipping user or sending user. In particular, Claim 12 further recites:

... according to the request by the second user, collecting, from the first user via a first set of interactive accesses to the shipping management computer system by a first computer device, a set of information corresponding to the request comprising: (A) parcel specifications for shipping the particular parcel to the destination to be designated by the second user, (B) an origin address associated with the first user from which the particular parcel would be shipped, and (C) shipping preferences for shipping the particular parcel to the second user ...

Similar to Claim 12, as distinguished from the Office Action's above-cited characterizations of *Kara II*, Claim 30 claims receiving recipient information from a second user (such as, for example, the buying user referred to above), designating a destination to which a parcel (such as, for example, the purchased item referred to above) is to be shipped, and receiving parcel specifications from a first user (such as, for example, the selling user referred to above) that will ship the parcel to the destination designated by the second user. In particular, Claim 30 recites:

(A) receiving from a first user client computer device through a first access path, an input by a first user of a set of parcel specifications corresponding to a transaction between the first user and the second user for a particular parcel to be shipped by the first user to a destination to be designated by a second user, said set of parcel specifications comprising:

- (1) an origin address associated with the first user, and
- (2) at least one of:
  - a parcel type,
  - a set of parcel dimensions,
  - a package weight, or
  - a value of the particular parcel,

(B) receiving from a second user client computer device through a second access path, an input by the second user corresponding to the transaction between the first user and the second user of a set of recipient information for a delivery of the particular parcel to a destination indicated by the second user, said set of recipient information comprising:

- (1) a delivery address to which the particular parcel is to be delivered,
- (2) a delivery service by which the particular parcel is to be delivered to the delivery address, and

(3) a carrier that is to deliver the particular parcel to the delivery address;

It is respectfully asserted that Kara II fails to disclose the above-recited limitations of Claims 12 and 30. See also, e.g., Smith Decl'n, ¶35. In considering distinctions between the claimed invention and Kara II, it is respectfully submitted that the abstract of Kara II is instructive. According to Kara II:

A system and method for transmission of a document from a sending location to a receiving location by way of a trusted way location is disclosed. A selected document is physically or electronically transmitted by a sending location to a letter server operated by a delivery service. A confirmation of transmission of the document is provided to the sender by the delivery service. Thereafter, the letter server reproduces the document in original quality, accompanied by any necessary items such as a delivery container and/or delivery instructions. The delivery service then delivers the reproduced document such as through electronic delivery or inducting the reproduced document into its delivery paradigm for physical delivery to the indicated recipient.

Kara II, Abstract.

According to the above-quoted Abstract of Kara II, a sender (e.g., a first user) sends/transmits a document to a second location (a letter server operated by a delivery service). The delivery service then delivers the document to the indicated recipient. See, e.g., Kara II, Abstract.

Even assuming for the sake of argument that the delivery service could be characterized as a "second user" as recited by, for example, Claims 12 and 30, it is respectfully asserted that there is no evidence that Kara II discloses, or even contemplates, as recited by Claim 12, "... a request from ... a second user that a first user ship a particular parcel to a destination to be designated by the second user ....". That is, it is respectfully submitted that there is no disclosure in Kara II that the delivery service requests that the sender (the first user) ship a parcel to the delivery service (as, e.g., a second user).

Similarly, it is respectfully asserted that there is no evidence that Kara II discloses, or even contemplates, as recited by Claim 30, "...receiving from ... a first user ... a set of parcel specifications corresponding to a transaction between the first user and the second user for a particular parcel to be shipped by the first

user to a destination to be designated by a second user ... [and] *receiving ... an input by the second user corresponding to the transaction between the first user and the second user* of a set of recipient information for a delivery of the particular parcel to a destination indicated by the second user ...." (Emphasis added). *See also, e.g., Smith Decl'n, ¶35.*

The Office Action suggests that the *Kara II* recipient could be considered the second user. See, e.g., Office Action, Topic Nos. 3 and 3.c. In particular, the Office Action states that "Kara discloses ... c. Collecting, from a second user, destination address which includes a zip code (Kara discloses providing a delivery service with information as to how the documents should be delivered ....Page 14, lines 13-28, the recipient discloses whether the mail is sent via physical mail, or electronic mail ..." Office Action, Topic Nos. 3 and 3.c.

However, as compared to the above-described suggestion by the Office Action, it is respectfully asserted that there is no evidence that *Kara II* discloses, or even contemplates, as recited by Claim 12, "... a request from ... a second user that a first user ship a particular parcel to a destination to be designated by the second user ...." That is, it is respectfully submitted that there is no disclosure in *Kara II* that the recipient requests that the sender (the first user and the shipper) ship a parcel to a destination designated by the *Kara II* recipient. Rather, as noted above, *Kara II* merely discloses a first user sending a document to a delivery company which in turn reproduces the document and sends the copy to an indicated recipient.

Further, for the reasons given below, Applicants respectfully assert that in view of the amendments to Claims 12 and 30, contrary to the assertion in the Office Action (Office Action, Topic No. 31, p. 14 (stating that "the limitation of collecting a request from a 'second user' is not considered to be a functional limitation, due to the fact that the software would run the same regardless of if the request was coming from a first user or a second user."), the claimed limitations are functional.

First, it is respectfully submitted that the Office Action fails to cite any evidence to support the assertion that "... the software would run the same

regardless of if the request was coming from a first user or a second user." See Office Action, Topic No. 28, p. 14.

Further, it is respectfully asserted that amendments to Claims 12 and 30 more distinctly claim functional limitations that, for reasons described in more detail below, result in processing by the claimed system that is different than would be so if all of the input were collected from a single source.

In particular, as claimed by Claim 12, the claimed system would function to collect some information from a first user via a first computer device, and to collect other information from a second user via a second computer device, all with respect to a "particular parcel" and all corresponding to a request by the second user. The Specification of the present application describes non-limiting exemplary embodiments, such as of the recitations of Claim 12, regarding collecting some information from a first user and other information from a second user. See, e.g., Specification, p. 40, line 12 – p. 44, line 17.

Further, as explained in the Smith Decl'n, multi-source input and processing features of various embodiments of the shipping management system, as claimed by independent Claims 12 and 30, are functionally different from a system that merely receives all input for shipment from a single source. See Smith Decl'n, ¶¶31-34. In a system that merely receives all input for shipment from a single source, such a system typically interacts in a single online session, or through a single access path, or otherwise through a single client-computer-specific set of interactive accesses, with a single remote client computer, such as for the shipper, to collect parcel, origin, destination and payment information regarding a single shipment transaction. In such a scenario, such a single online session involves an interaction between the system and a single remote online address. See also Smith Decl'n, ¶31.

As compared to a system that merely receives all input for shipment of a parcel from a single source, such as, for example, from a shipper, it is respectfully asserted that various embodiments of the shipping management system claimed in Claims 12 and 30 coordinate different-online-session input from multiple remote online addresses to process a single transaction, and then

combine the information received during different online sessions from multiple remote online addresses and generate a shipping label for print rendering on a print rendering device at one of those remote online addresses. See also Smith Decl'n, ¶32.

Further, as compared to a system that merely receives all input for shipment of a parcel from a single source, it is respectfully asserted that various embodiments of the multi-source processing shipping management system claimed in Claims 12 and 30 recognize a remote online address of a computer used by a party such as an exemplary eCommerce buyer who is, for example, buying an item from another party, such as, for example, a particular exemplary eCommerce shipper during an exemplary buying session, and associate the information provided by the exemplary eCommerce buyer with information provided by the exemplary eCommerce seller from a different remote online address, possibly from interactive sessions that occur at different times. See Smith Decl'n, ¶ 33.

As further compared to a system that merely receives all input for shipment of a parcel from a single source, it is respectfully asserted that once the exemplary eCommerce buyer has input destination address and item/shipment payment information, various embodiments of the multi-source processing shipping management system claimed in Claims 12 and 30 may calculate a shipping rate corresponding to the exemplary buying session according to the separate inputs by the exemplary eCommerce buyer and the exemplary eCommerce seller. See also Smith Decl'n, ¶ 34. In particular, amended Claim 12 recites:

... calculating a shipping rate corresponding to the request, according to the set of recipient information collected from the second user and according to the set of information collected from the first user, to be charged for having the carrier ship the particular parcel from the origin address to the destination address via the delivery service ...

Amended Claim 30 similarly recites functional limitations regarding the different sourced input, as follows:

... calculating a shipping rate corresponding to the transaction between the first user and the second user, according to the input by the first user and the input by the second user, for shipping the particular parcel from the origin address to the delivery address via said delivery service and said carrier ...

Further still, it is respectfully asserted that the rule that prescribes giving claims the broadest interpretation (See, e.g., MPEP §2106) does not allow an interpretation to flip-flop definitions of the interpreted elements in the interpretation of a single claim. That is, in the present case of Claim 12, for example, the claimed "a first user" should not, for one claimed term of Claim 12, be interpreted as the sender; then for another claimed term of Claim 12, be interpreted as the recipient; and/or then, for another claimed term of Claim 12, be interpreted as the delivery service. Accordingly, because the plain language of Claim 12 claims that the first user ships, (a first user ship a particular parcel from the first user to a destination to be designated by the second user), then it is respectfully asserted that the claimed "first user" in Claim 12 must consistently be interpreted for Claim 12 as a shipper, a shipping user, a sending user, or someone representing a shipper, shipping user or sending user. Further, because the plain language of Claim 12 claims that the first user ships a parcel from the first user to a destination to be designated by the second user, it is respectfully asserted that the second user must consistently be interpreted for Claim 12 as a buyer, a buying user, a recipient, someone representing a buyer, or a recipient, or some other party requesting that a first user ship an item to a destination indicated by the second user.

Yet further, for the reasons given below, it is respectfully asserted that contrary to the above-cited characterizations by the Office Action of Kara II regarding the asserted disclosure by Kara II (see, e.g., Office Action, Topic Nos. 3.b – 3c, pgs. 2-3), Kara II discloses that a first Kara II user (i.e., a Kara II sender), not a second (buying or recipient) user, provides both origin address and delivery address. Specifically, Kara II discloses that,

"...[p]referably, the sender indicates a preference for delivery of the document, such as through inclusion of delivery address information. Where this information is a physical address it might be presumed that

delivery is to be physical, by way of postal delivery. Likewise, where the address information indicates an electronic address, such as a telephone number or e-mail address, delivery might be presumed to be commensurate with such addressing schemes."

Kara II, p. 14, lines 3-9.

The Office Action cites p. 14, lines 13-28 of Kara II for support of the proposition that Kara II "...discloses providing a delivery service with information as to how the documents should be delivered, and delivery preferences, which includes service as well as address ...." Office Action, Topic No. 3.c, pgs. 3-4. However, as compared to the above-cited assertion by the Office Action, it is respectfully submitted that the cited portion of Kara II does not disclose a buying user or a recipient as providing any address. Specifically, the cited portion of Kara II states:

Of course, a recipient of such documents may indicate a preferred method of delivery. For example, recipients may provide the delivery service with information, as to how documents should be delivered, that is stored by the delivery service for subsequent reference when a document is to be transmitted. Such delivery preference information may include strata of delivery choices, such as identify of senders or types of documents for which a particular delivery method is to be used. Accordingly, a recipient may prevent the electronic delivery of unsolicited or unwanted documents through such systems as e-mail and relegate such documents to delivery by more conventional means. Moreover, a recipient might even designate certain types of documents and/or particular senders for which document delivery may be forgone; if desired.

Kara II, p. 14, lines 12-22.

In view of the above-quoted explanation by Kara II, it is respectfully asserted that, as compared with the assertion by the Office Action that Kara II "...discloses providing a delivery service with information as to how the documents should be delivered, and delivery preferences, which includes service as well as address ..." (Office Action, Topic No. 3.c, pgs. 3-4 (emphasis added)), Kara II does not disclose a first user (such as a recipient or buying user) providing "... a destination address to which the particular parcel is to be shipped by the first user ..." as claimed by Claim 12. More specifically, it is respectfully asserted that the above-quoted portion of Kara II cited in the Office Action (Office

Action, Topic No. 3.c, pgs. 3-4 citing Kara II, p. 14, lines 13-28), contains no disclosure that the Kara II recipient ever provides the Kara II recipient's address. Yet further, it is respectfully asserted that there is no evidence that a Kara II recipient would provide the Kara II recipient's address because, according to Kara II, the Kara II recipient's address has already been provided by the Kara II sender. See, e.g., Kara II, p. 14, lines 3-9.

Yet further, even assuming (which Applicants do not), for the sake of argument only, that the above-quoted disclosure of Kara II could be extended to include a Kara II recipient providing a Kara II delivery service with address information, it is respectfully asserted that doing so would not comprise a second user (such as a recipient or buying user) providing "... a destination address to which the particular parcel is to be shipped by the first user ..." as claimed by Claim 12. Rather, according to the cited p. 14, lines 12-22 quotation from Kara II, it is respectfully asserted that a Kara II user that provided information would be doing so to *the delivery service* to deliver a document in the possession of the delivery service, not "... to which the particular parcel is to be shipped by *the first user* ..." as claimed by Claim 12 (emphasis added).

Citing page 12, lines 18-28 of Kara II, the Office Action further posits that Kara II discloses calculating a shipping rate. Office Action, Topic No. 3.d, p. 4.

However, as further distinguished from the Office Action's characterization that Kara II discloses calculating a shipping rate, Claim 12, for example, recites:

... calculating a shipping rate corresponding to the request, according to the set of recipient information collected from the second user and according to the set of information collected from the first user, to be charged for having the carrier ship the particular parcel from the origin address to the destination address via the delivery service ...

As compared to the above-recited limitation of Claim 12, the above-cited page 12, lines 18-28 of Kara II states, in pertinent part:

... at a point in the paradigm very near the actual delivery of the document, ... providing for rate discounts such as by batching mail items by ZIP code, etc. ...

Kara II, p. 12, lines 25-27.

It is respectfully asserted that a disclosure in Kara II for “..... providing for rate discounts such as by batching mail items by ZIP code, etc. [at a point in the paradigm very near the actual delivery of the document] ...” (emphasis added), does not disclose “... calculating a shipping rate ... to be charged for having the carrier ship the particular parcel from the origin address to the destination address via the delivery service ...” (emphasis added), as claimed by Claim 12.

Yet further, it is respectfully submitted that Kara II contains no disclosure that the recipient is even a user of the Kara II system. Rather, as explained in Kara II, “...recipients may provide the delivery service with information ... that is stored by the delivery service ....” Kara II, p. 14, lines 13 - 14.

For the reasons given and the authorities cited above, it is respectfully asserted that the references cited by the Office Action, even when considered in combination, do not disclose, anticipate, teach or suggest all of the limitations recited by independent Claims 12 and 30.

Accordingly, for the above-given reasons and authorities, in view of the above-described distinctions between the references of record on the one hand, and the limitations claimed by independent Claims 12 and 30, on the other hand, it is respectfully asserted that independent Claims 12 and 30, and the claims dependent on them, namely, Claims 54-57, are in condition for allowance.

**With Regard to Independent Claim 27, There is No Disclosure in Kara or the Other References of Record of Applying Carrier-Specific Shipping Location Rules to a User's Default Shipping Location to Determine Whether a Carrier Would Support Shipping a Particular Parcel From the User's Default Shipping Location**

It is respectfully asserted, for the reasons given and authorities cited below that the references of record, including Kara, do not disclose, anticipate, teach or suggest applying a carrier's shipping location rules to a user's default shipping location in order to determine whether the carrier would support shipping a particular parcel from the user's default shipping location as claimed by Claim 27.

It is respectfully asserted that in order to ascertain the meaning of limitations claimed by Claim 27, such as, for example, the limitation "...apply a respective set of carrier-specific shipping location rules to the default shipping location to determine which of said plurality of carriers would support shipping the particular parcel from the default shipping location ..." it is proper to consider the Specification of the present patent application. See, e.g., Markman v. Westview Instruments, Inc., 52 F.3d 967, 979, 34 U.S.P.Q.2D (BNA) 1321, 1329 (Fed. Cir. 1995) (*in banc*), aff'd, 517 U.S. 370 (1996) ("To ascertain the meaning of claims, we consider three sources: The claims, the specification, and the prosecution history." (citations omitted)).

It is respectfully asserted that the phrase "...apply a respective set of carrier-specific shipping location rules to the default shipping location to determine which of said plurality of carriers would support shipping the particular parcel from the default shipping location ..." recited by Claim 27 is properly interpreted to mean applying the rules by which each particular carrier of a plurality of carriers would determine whether or not the particular carrier would support shipping a particular parcel from a particular user's default shipping location and determining whether, according to the application of the respective carrier's rules, the carrier would support shipping the particular parcel from the particular user's default shipping location. See, e.g., Specification, p. 2, lines 6-7 ("... Each Carrier has its own unique rating schedule, and delivery and pickup rules and schedules for each of a multitude of different services."); see also, e.g., Specification, p. 51, lines 18-25; Specification, p. 36, line 26 – p. 37, line 1; Specification, p. 62, lines 10-19 ("...the System then determines whether the Shipper has requested a 'Call for Pickup' shipping location .... If so, the System accesses the Carrier Database ... to determine whether the particular Carrier/Service supports 'Call for Pickup' services ... If the particular Carrier/Service does not support 'Call for Pickup' services, [t]hen the particular Carrier/Service is eliminated from the delivery rate set ... and the System proceeds with the next Carrier/Service in the delivery rate set ... If the particular Carrier/Service supports 'Call for Pickup' services, the System adds the

appropriate charge for the 'Call for Pickup' service to each of the particular Carrier/Service's delivery rates ...." ).

It is respectfully asserted that claimed terms "... must be understood in the context in which the inventor presents it." *In re Glaug*, 283 F.3d 1335, 1340, 62 U.S.P.Q.2d 1151, \_\_\_\_ (Fed. Cir. 2002) (citation omitted). Accordingly, it is respectfully asserted that, in view of the above-given reasons for the proper interpretation of the claimed limitation "... apply a respective set of carrier-specific shipping location rules ....," even if the claimed limitation may be "... susceptible to various meanings, ... the inventor's lexicography must prevail ...." *Id. (citations omitted)*.

In light of the above-explained proper interpretation of the claimed limitation to "... apply a respective set of carrier-specific shipping location rules ....", it is respectfully asserted that a disclosure by a reference of an identification of delivery services that would support shipping a parcel that does not include consideration of the relevant carrier's shipping location rules as applied to a particular parcel's specifications and as applied to a particular shipper's default shipping location, does not disclose, anticipate, teach or suggest the limitations of Claim 27 to "... determine which of said plurality of carriers would support shipping the particular parcel from the default shipping location ...."

In view of the above-explained proper interpretation of the claimed limitation to "... apply a respective set of carrier-specific shipping location rules ....," for the reasons given and the authorities cited below, it is respectfully asserted that *Kara* does not disclose, anticipate, teach or suggest consideration of the relevant carrier's shipping location rules as applied to a particular parcel's specifications and as applied to a particular shipper's shipping (ship-from) location in the manner claimed by Claim 27.

It is respectfully asserted, for the reasons given below, that although the references of record mention consideration of zone information and/or collection of return address information, there is no disclosure in any of the references of record of any distinction between carriers and/or services as to differences in

support for different shipping (ship-from) locations, including different shipping locations that may exist within a single ship-from zone as claimed by Claim 27.

In rejecting Claim 27, the Office Action asserts that the Return address disclosed in *Kara* (reference numeral 803) discloses a default shipping location. *Office Action*, Topic No. 6.g, p. 4.

First, it is respectfully noted that a user's default shipping location as the term is used in Claim 27 may be different from a user's return address. For example, a user's return address may be a residence; whereas a user may take their parcels for shipping to a nearby retail shipping store, such as a Mail Boxes, etc. location.

Even so, assuming for the sake of argument that a particular user may wish to use the particular user's return address as the particular user's default shipping location, the claimed limitations recited by Claim 27 provide that the claimed computer system is programmed to:

... receive from a particular user ... an identification of a default shipping location associated with the particular user to which the particular user will drop off parcels to be shipped ...

The Office Action cites Figure 8 of *Kara* and the specification of *Kara* at column 21, lines 8-28 and at column 22, lines 1-19 as supporting an assertion by the Office Action that *Kara* discloses the limitations claimed by Claim 27 to "... apply a respective set of carrier-specific shipping location rules to the default shipping location to determine which of said plurality of carriers would support shipping the particular parcel from the default shipping location ...." *Office Action*, Topic No. 6.h, p. 5.

As compared to the above-recited limitations of Claim 27 regarding receiving a user's indication of the user's default shipping location and applying carrier-shipping location rules to that indication of a default shipping location, column 21 of *Kara* at lines 8-28 merely describes a *Kara* user's ability to input class and urgency information and recipient address information.

As distinguished from a recipient's address, it is respectfully asserted that, from the plain language of Claim 27, the claimed system is programmed to

receive from a user, the user's "identification of a default shipping location associated with the particular user to which the particular user will drop off parcels to be shipped." That is, even if the user wished to indicate that the user's "default shipping location" was the user's return address, various exemplary embodiments of Claim 27 would receive from the user an identification to the system of the user's default shipping location so that the claimed system could then "... apply a respective set of carrier-specific shipping location rules ..." to that location. It is respectfully asserted that, as compared to the above-cited limitations of Claim 27, Kara only provides for a user to input the user's return address and does not provide a way for a Kara user to indicate a location, whether the user's return address or other location, from which the user will ship parcels.

Further, it is respectfully asserted that Kara's provision of an input for a user's return address does not disclose or infer that the Kara system considers the return address to be a shipping location or that the Kara system would apply carrier-specific shipping location rules as claimed by Claim 27 to the Kara user's return address to determine carrier/delivery service availability for that location.

Quite the contrary, Kara teaches that carrier/delivery service availability is zone-based, as compared to shipping-location based as claimed by Claim 27. In particular, as compared to the increased granularity of the limitations claimed by Claim 27, Kara explains with reference to element 714 in FIG. 7 of Kara that:

At step 714, the user may select a particular zone associated with the mail piece or other item. Such information may be utilized in the determination of the proper amount of postage or other fees associated with the shipping of the item. Additionally, this zone information may be utilized in determining the availability of a particular delivery service, such as overnight, certified, or the like, available from particular ones of the shipping service providers.

Kara, col. 21, lines 60-67. See also, e.g., Kara, col. 21, lines 60-67 (explaining that "... zone information may be utilized in determining the availability of a particular delivery service, such as overnight, certified, or the like, available from particular ones of the shipping service providers.").

As compared to a particular, discrete location from which a user will ship a package, as claimed by Claim 27, it is respectfully asserted that the "Zone" element 714 described in *Kara* is a broad designation of a geographic area. See, e.g., Element 714 of FIG. 7 of *Kara* stating "ZONE – Select from Box: Local; 1 to 8; Canada, Mexico or International." Further, it is respectfully asserted that the "Zone" element 714 described in *Kara* is associated with the *destination zone* for a particular mail piece, as reflected in the description of element 714 in FIG. 7 of *Kara*.

Yet further, even assuming for the sake off argument only, that the zone-based considerations described in *Kara* could be taken to include origin zone as well as destination zone, it is respectfully asserted that zone-based calculations are just that – calculations based on large geographic zones that do not consider the finer granularity provided by the limitations claimed by Claim 27 to consider particular shipping locations.

Further still, it is respectfully asserted that such zone-based considerations do not disclose or infer differences, and the Office Action has failed to cite any, in carrier/delivery service availability for differing shipping locations, such as different shipping locations within a zone, as claimed in Claim 27.

It is respectfully asserted that the claimed application of carrier shipping location rules is distinguished from, and useful over, different carrier treatment of destination zone information. In particular, it is respectfully asserted that the claimed application of carrier-specific shipping location rules to a user's default shipping location would provide the user with an identification of which carriers of a plurality of carriers would support shipping a particular parcel from the user's shipping location, and which would not.

It is respectfully asserted that, for the reasons described above, although the references of record mention consideration of large geographic zones, there is no mention in any of the references of record of any distinction between carriers and/or services as to differences in support for different shipping locations that may exist within a single zone.

For the above-given reasons and authorities, in view of the above-described distinctions between the disclosures of *Kara* on the one hand, and independent Claim 27 on the other hand, it is respectfully asserted that Claim 27 is patentable over the references of record, and it is therefore respectfully asserted that Claim 27 is in condition for allowance.

**Regarding Independent Claim 50, There is No Disclosure in Kara of Determining Carrier-Specific Origin and Destination Rating Zone Identifiers**

In rejecting Claim 50 under Section 102(e) as being anticipated by *Kara*, the Office Action cited *Kara*'s column 21, lines 60-67 as supporting the proposition that "... Kara discloses a shipping management computer system that is programmed to ... determine a first and second carrier specific origin rating zone identifier ... [and] determine a first and second carrier specific destination rating zone identifier ...." *Office Action*, Topic Number 7, pgs. 5-6.

As compared to the above-described position by the Office Action, it is respectfully submitted that *Kara*'s column 21, lines 60-67 states that "... the *user* may select a particular zone associated with the mail piece of other item ..." (Emphasis added). It is respectfully asserted that a *user selecting* a particular zone associated with a mail piece as disclosed in the cited excerpt of *Kara* is distinguished from a *system determining a rating zone identifier* as recited in amended Claim 50 as follows:

(a) determining a first carrier-specific origin rating zone identifier that a first carrier would associate with the origin postal code according to an indication in a memory storage accessible by the shipping computer system comprising an identification of first carrier-specific origin rating zone identifiers associated with origin postal codes;

(b) determining a second carrier-specific origin rating zone identifier that a second carrier would associate with the origin postal code according to an indication in a memory storage accessible by the shipping computer system comprising an identification of second carrier-specific origin rating zone identifiers associated with origin postal codes;

(c) determining a first carrier-specific destination rating zone identifier that said first carrier would associate with the destination

postal code according to an indication in a memory storage accessible by the shipping computer system comprising an identification of first carrier-specific destination rating zone identifiers associated with destination postal codes;

(d) determining a second carrier-specific destination rating zone identifier that said second carrier would associate with the destination postal code according to an indication in a memory storage accessible by the shipping computer system comprising an identification of second carrier-specific destination rating zone identifiers associated with destination postal codes;

Further, with respect to the rejection of Claim 50 under Section 102(e) as being anticipated by *Kara*, the Office Action cited *Kara*'s FIG. 8 to support the proposition that "... Kara discloses a shipping management computer system that is programmed to ... [c]alculate[,] using zone identifiers, rates of first and second delivery services of the first and second carriers ...." *Office Action*, Topic Nos. 7 and 7.I.iv, pgs. 5-6.

However, as compared to the above-described position by the Office Action, it is respectfully submitted that although *Kara* discloses a comparison of rates across multiple carriers, *Kara* first requires a user's pre-selection of a delivery service "urgency" and/or class, and therefore does not disclose calculating rates for more than one delivery service for a particular carrier. See, e.g., *Kara*, col. 22, lines 39 – 42 ("the ... program automatically calculates the [shipping] fees for each shipping service provider offering service *commensurate with the desired shipping and/or delivery parameters*." (emphasis added). That is, according to *Kara*, a user of *Kara* must first indicate the desired shipping and/or delivery parameters (e.g., Overnight, or Same Day, or Next Day, or 2-Day, or 3-Day) so that the *Kara* "program [will] automatically calculate[ ] the [shipping] fees for each shipping service provider offering service *commensurate with the desired shipping and/or delivery parameters*." *Kara*, col. 22, lines 39 – 42 (emphasis added).

As distinguished from a user pre-selecting a delivery service as disclosed in *Kara*, Claim 50 recites, in response to receiving a request to ship a particular parcel, among other things:

(e) calculating a first service-specific, carrier-specific shipping rate for a first delivery service offered by said first carrier according to at least the first carrier-specific origin rating zone, the first carrier-specific destination rating zone, and the set of parcel specifications;

(f) calculating a second service-specific, carrier-specific shipping rate for a second delivery service offered by said first carrier according to at least the first carrier-specific origin rating zone, the first carrier-specific destination rating zone, and the set of parcel specifications;

(g) calculating a third service-specific, carrier-specific shipping rate for a first delivery service offered by said second carrier according to at least the second carrier-specific origin rating zone, the second carrier-specific destination rating zone, and the set of parcel specifications;

(h) calculating a fourth service-specific, carrier-specific shipping rate for a second delivery service offered by said second carrier according to at least the second carrier-specific origin rating zone, the second carrier-specific destination rating zone, and the set of parcel specifications ....

That is, even assuming for the sake of argument that Kara could be used to execute each of the above-outlined processes, it is respectfully asserted that there is no disclosure in Kara, that Kara could do so in response to the singular receipt of a request to ship a particular parcel. Rather, it is respectfully asserted that according to the disclosure of Kara, even assuming for the sake of argument that Kara could be used to execute each of the above-outlined processes, Kara could only be used to do so in multiple stages -- each stage requiring a user to first pre-selected a delivery service "urgency" and/or class. See, e.g., Kara, col. 22, lines 39 – 42.

Further, amended Claim 50 recites:

(i) generating a display to a display device disposed for communication with the respective user client computer device, of a simultaneous cross-comparison of the first, second, third and fourth service-specific, carrier specific shipping rates.

It is respectfully asserted that Kara does not disclose the above-recited combination of limitations of Claim 50.

For the above-given reasons, in view of the above-described distinctions between the disclosures of Kara on the one hand, and independent Claim 50 on

the other hand, it is respectfully asserted that Claim 50 is patentable over the references of record, and it is therefore respectfully asserted that Claim 50 is in condition for allowance.

**Regarding Claim 44 and the Claims Dependent on it, Namely, Claim 45, Nicholls Fails to Disclose or Anticipate Communicating with Devices that are Peripheral to, or in Communication With, Client Computers that Access the Claimed System using Software for Retrieving or Rendering Hyper-Media Content, and Fails to Disclose or Anticipate Generating an Executable Set of Instructions for Automatically Regenerating an Interactive User Interface Display in Response to a User Modification of Data in a Data Collection Field or Sending Such Executable Instructions to Client Computer Devices**

It is respectfully asserted that rejected Claims 44 and 45 of the present application are directed to communicating with devices that access the online interactive shipping management computer system of Claims 44 and 45 using a web browser or other software for retrieving or rendering hyper-media content.

In rejecting Claim 44 under Section 102(e) as being anticipated by *Nicholls*, the Office Action cites the “Rate button” and the “Repeat button” of FIG. 4B of *Nicholls* to support the proposition that “... Nicholls discloses a shipping management computer system that is programmed to ...generat[e] an interactive user display ... comprising ... an executable set of instructions for regenerating the interactive user interface display in response to a user modification of data ....” *Office Action*, Topic No. 9.o.vii, p. 7.

In rejecting Claim 44, the Office Action further asserts that “[t]he claim limitation merely reads ‘regenerating ... in response to a user modification of data’. The claim does not state that it is automatically regenerated without user interaction.” *Office Action*, Topic No. 31, p. 16.

However, as compared to a user needing to click a separate “Rate,” “Update,” “Repeat” or other-named “button” in order to regenerate an updated version of a screen, Claim 44, has been amended herewith, to expressly recite “...an executable set of instructions for automatically regenerating the interactive user interface display *in response to a user modification of data in the at least*

*one data collection field, the executable set of instructions disposed for automatic installation on the client computer device, said executable program instructions disposed to automatically execute on the client computer device to automatically regenerate the interactive user interface display in response to a user modification of data in the at least one data collection field.” (Emphasis added.) Accordingly, it is respectfully requested that Claim 44, and dependent Claim 45, be reconsidered in light of the amendments.*

It is respectfully asserted that the Specification of the present application supports the amendments to Claim 44. See, e.g., Specification, p. 64, lines 3-7; Specification, p. 63, line 18 – p. 64, line 2. Specification, p. 64, lines 18 – 23.

For the reasons given, and under the authorities cited, above, it is respectfully asserted that the references of record do not disclose, anticipate, teach or suggest the above-recited limitations of amended Claim 44, or the limitations of Claim 45 which is dependent on amended independent Claim 44. Accordingly, it is respectfully asserted that Claims 44 and 45 are patentable over the references of record, and are in condition for allowance.

**Regarding Claim 49, The Combination Asserted by the Office Action of Nicholls, Kara and InterShipper Fails to Disclose, Anticipate, Teach or Suggest the Combination of All of the Limitations Recited by Claim 49**

Similar to the rejection of Claim 31, the Office Action rejects Claim 49 on two grounds: 1.) under 35 U.S.C. §103(a) as being unpatentable over Nicholls in view of Kara (Office Action, Topic No. 13, p. 8); and 2.) under 35 U.S.C. §103(a) as being unpatentable over Nicholls in view of Kara and InterShipper (Office Action, Topic No. 16, p. 9). However, the Office Action only discusses Claim 49 under the rejection over Nicholls in view of Kara and InterShipper (Office Action, Topic Nos. 20-22). Therefore, the rejection of Claim 49 under 35 U.S.C. §103(a) as being unpatentable over Nicholls in view of Kara and InterShipper is discussed below.

In rejecting Claim 49, the Office Action repeats many of the same

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assertions that were made regarding the rejection of Claim 31 with respect to instructing a client computer to recognize a measured weight, instructing the client computer to communicate the measured weight, and the like. See, e.g., Office Action, Topic No. 20, pgs. 10-11. However, as compared to the aforementioned assertions in the Office Action regarding Claim 49, it is respectfully asserted that Claim 49 does not recite the limitations regarding weight asserted in the Office Action.

In rejecting Claim 49, the Office Action also states that "Nicholls and Kara, disclose the use of calculating and displaying rates for specific services, for multiple carriers, but fails to disclose the simultaneous display of rates for each carrier that includes rates of different services ...." Office Action, Topic No. 22, p. 11.

In order to compensate for the above-quoted statement of failure by the Office Action of Nicholls and Kara, the Office Action then asserts that: "Intershipper is an internet, online website, where internet users can enter origin, destination, package weight and dimensions and will be displayed every method possible that you can use to ship your package for all major shippers (See Internet Update Article Page 1, Paragraphs 1-3." Office Action, Topic No. 22, pgs. 11-12. The Office Action further asserts that "[i]t would have been obvious ... to display every method possible to ship a package, as disclosed by InterShipper, in order to find the cheapest shipping rate (See Page 1)." Office Action, Topic No. 22, pgs. 11-12.

The rejection of Claim 49 under Section 103(a) as being unpatentable over Nicholls in view of Kara and Intershipper, has been carefully considered. Applicant(s) respectfully disagree with the rejection for the following reasons and authorities, and respectfully assert that Claim 49 is in condition for allowance.

As mentioned above, the initial assertions by the Office Action regarding instructing a client computer to recognize a measured weight, instructing the client computer to communicate the measured weight, and the like (Office Action, Topic No. 20, p. 10) are not limitations recited by Claim 49.

In rejecting Claim 49, the Office Action states that "Nicholls discloses ... [r]eceiv[ing] the measured weight by the user (See Figure 4A), this weight is used to calculate the weight of the parcel, therefore the examiner considers this to be a ratable weight ...." Office Action, Topic Nos. 20 and 20.aa, pgs. 10-11. However, it is respectfully asserted that the Office Action fails to cite any portion of Nicholls that supports the above-quoted assertion that "this weight is used to calculate the weight of the parcel." See, e.g., Office Action, Topic Nos. 20 and 20.aa, pgs. 10-11. Accordingly, it is respectfully asserted that the rejections by the Office Action fail to show that the cited references use a set of parcel characteristics and carrier-specific weight calculation rules to derive carrier-specific ratable weights for a particular parcel as claimed by Claim 49.

Further, it is respectfully asserted that the Office Action fails to show that any of the cited references use the derived carrier-specific ratable weights to determine whether or not the relevant carrier would support shipping a particular parcel as claimed by Claim 49. Further still, it is respectfully asserted that the Office Action fails to show that, if a carrier would support shipping a particular parcel, calculating a service-specific, carrier-specific shipping rate for more than one delivery service offered by a carrier as claimed by Claim 49.

Yet further, it is respectfully asserted that contrary to the above-quoted assertion by the Office Action, Nicholls does not disclose the above-recited processes claimed by Claim 49 or the claimed simultaneous display of the above-recited calculated shipping rates.

It is respectfully asserted that InterShipper fails to add anything regarding consideration of a simultaneous display as claimed by Claim 49. In particular, InterShipper only states "[s]imply enter your origin, anywhere in the U.S. is OK, and destination, worldwide, along with your package weight and dimensions. The free service will return every method possible that you can use to ship your package . . ." InterShipper, p. 1, ¶ 2.

It is respectfully submitted that, as compared to the limitations recited by Claim 49, InterShipper does not state that its display comprises a display of rates for multiple delivery service offered by multiple carriers. It is respectfully

submitted that the author of the *InterShipper* article merely describes that the “[t]he free service will return every method possible that you can use to ship your package . . . .” *InterShipper*, p. 1, ¶ 2. In particular, the author of *InterShipper* did not state, and the *InterShipper* article does not disclose, that “every method” means multiple delivery services offered by multiple carriers as claimed Claim 49. Further, it is respectfully submitted that there is no evidence that the author of the *InterShipper* article had any particular expertise in shipping. Therefore, it is respectfully asserted that the *InterShipper*’s author’s reference to “every method” may have referred to a plurality of carriers, but not to multiple delivery services offered by that plurality of carriers as claimed by Claim 49.

In view of the failure of the *InterShipper* article to specifically disclose the limitations of rejected independent Claim 49, it is respectfully asserted that the Office Action’s assertion of obviousness of independent 49 is a reading influenced by the disclosures of the present application and rejected independent Claim 49. Moreover, it is respectfully asserted that use by the Office Action of the disclosures of the present application and rejected independent 49 as a roadmap to support the assertions of obviousness of the rejected Claims is prohibited. Cf., e.g., *In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), aff’d, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995) (Opinion by Judge Easterbrook; “... decomposing an invention into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden *ex post* analysis. ... With hindsight the transistor is obvious; but devising the transistor was still a work of genius. An invention lies in a combination of elements that are themselves mundane. ‘Virtually all inventions are combinations and virtually all are combinations of old elements.’.....”).

Yet further, it is respectfully submitted that *InterShipper* does not disclose that its display comprises a *simultaneous* display of rates for multiple delivery services offered by multiple carriers as claimed by Claim 49. Rather, it is respectfully submitted that the author of the *InterShipper* article merely describes that “[t]he free service will return every method possible that you can use to ship

your package . . . ." *InterShipper*, p. 1, ¶ 2. However, the author did not state, and the *InterShipper* article does not disclose, that "every method" is displayed simultaneously. Rather, in view of the failure of the *InterShipper* article to specifically disclose the limitations of rejected independent Claim 49, it is respectfully asserted that the Office Action's assertion of obviousness of independent 49 is a reading that impermissibly uses the disclosures of the present application and rejected independent Claim 49 as a roadmap. See *In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995).

Accordingly, in view of the above-given reasons and the authorities cited above, it is respectfully asserted that the above-recited limitations of Claim 49 are distinguished from and patentable over the references of record. Accordingly, it is respectfully asserted that Claim 49 is in condition for allowance.

**Regarding Independent Claims 33 and 34, The References of Record, Even When Considered in Combination, Fail to Disclose, Anticipate, Teach or Suggest the Combination of All of the Limitations Recited by Claims 33 and 34**

For reasons similar to those described above with respect to Claim 49, it is respectfully asserted that Claims 33 and 34 are distinguished from the references of record, even when those references are considered in combination, because Claims 33 and 34 are directed, in one way or another to calculating and simultaneously displaying shipping rates for more than a single delivery service for a plurality of carriers.

For example, Claim 33 recites:

(D) displaying, to a display device configured with the client computer device, a simultaneous preview of each shipping rate calculated in Step (C) above.

Similarly, Claim 34 recites:

(D) displaying, to a display device configured with the client computer device, a simultaneous online comparison comprising each service-specific, carrier specific shipping rate calculated in

Step (C) above.

For reasons similar to those given above regarding the rejection of Claim 49, it is respectfully asserted that Claims 33 and 34 are distinguished from and patentable over the references of record. Accordingly, it is respectfully asserted that Claims 33 and 34 are in condition for allowance.

**Regarding Independent Claims 35 and 42, The References of Record, Even When Considered in Combination, Fail to Disclose, Anticipate, Teach or Suggest the Combination of All of the Limitations Recited by Claims 35 and 42 (and Therefore Also Dependent Claim 45)**

As previously mentioned above, the Office Action does not expressly state grounds for the rejection of independent Claims 33, 34, 35 and 42. See Office Action, Topic Nos. 16-19, pgs. 9-10. The Office Action discusses the Nicholls reference with respect to independent Claims 33, 34, 35 and 42. See Office Action, Topic No. 17, p. 9. Subsequent to the discussion of Nicholls with respect to independent Claims 33, 34, 35, and 42, the Office Action discusses the Kara and InterShipper references. See Office Action, Topic Nos. 18-19, pgs. 9-10. For purposes of this Response, the discussion in the Office Action concerning the Kara and InterShipper references subsequent to the discussion of Nicholls with respect to independent Claims [33, 34,] 35, and 42, is taken to mean that Claims [33, 34,] 35 and 42 were rejected under Section 103(a) as being unpatentable over Nicholls in view of Kara and InterShipper.

The Office Action states that "Nicholls and Kara, disclose the use of calculating and displaying rates for specific services, for multiple carriers, but fails to disclose the simultaneous display of rates for each carrier that includes rates of different services ...." Office Action, Topic No. 19, p. 10.

It is respectfully submitted that the Office Action fails to point to any sections of the references of record that disclose determining delivery schedules (as claimed by Claim 35) or delivery dates and times (as claimed by Claim 42), as the case may be, for more than a single delivery service for a single carrier.

For example, Claim 35 recites:

(C) for each particular one of said plurality of carriers:

(1) determining a first service-specific, carrier-specific delivery schedule according to which said particular carrier would deliver said particular parcel via a first delivery service, said shipping management computer system being configured to determine said first service-specific, carrier-specific delivery schedule according to the origin identifier, the delivery destination identifier, the set of parcel specifications, and at least one service-specific, carrier specific delivery schedule rule associated with said first delivery service, and

(2) determining a second service-specific, carrier-specific delivery schedule according to which said particular carrier would deliver said particular parcel via a second delivery service, said shipping management computer system being configured to determine said second service-specific, carrier-specific delivery schedule according to the origin identifier, the delivery destination identifier, the set of parcel specifications, and at least one service-specific, carrier-specific delivery schedule rule associated with said second delivery service; and

(D) displaying, to a display device configured with the client computer device, a simultaneous online comparison comprising each service-specific, carrier specific delivery schedule determined in Step (C) above.

Similarly, Claim 42 recites:

(C) displaying to a display device configured with the client computer device, a simultaneous online comparison comprising each respective shipping rate determined in Step (3) above, wherein:

each of said respective shipping rates corresponds to a particular respective service offered by a particular respective carrier for delivering the respective parcel by a particular time on a particular day.

Because the Office Action failed to cite any reference as disclosing the above-recited limitations of Claims 35 and 42, it is respectfully requested that the rejection of independent Claims 35 and 42 be withdrawn and that those Claims be allowed.

**Regarding Independent Claim 36, The Rejections Do Not Accurately Represent the Claimed Limitations, There is Insufficient Support for Combining Fisher With Nicholls, and Even When Combined, the Cited References Do Not Disclose, Anticipate, Teach or Suggest the Combination of All of the Limitations Claimed by Claim 36**

In rejecting Claim 36, the Office Action mentions a reference identified in the Office Action only as "Fisher." Office Action, Topic No. 26, p. 12. In a previous Office Action, a reference named "Fisher" was identified as U.S. Patent No. 6,047,264 ("Fisher"). For purposes of this Response, the reference in the present Office Action to "Fisher" is taken to refer, therefore, to U.S. Patent No. 6,047,264.

The rejection of Claim 36 under Section 103(a) as being unpatentable over Nicholls in view of Kara , InterShipper and Fisher has been carefully considered. Claim 36 has been amended. For the reasons given, and the authorities cited, below, Applicant(s) respectfully assert that amended Claim 36 is in condition for allowance.

It is respectfully asserted that Claim 36 is distinguished from the cited references because Claim 36 is directed to determining, for each carrier-specific delivery service offered by each carrier, whether the respective carrier-specific delivery service would provide shipping notification for delivering a parcel.

In rejecting Claim 36, the Office Action states that "Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of Delivery (See Figure 4A ...." Office Action, Topic No. 24, p. 12.

Applicant(s) respectfully disagree that the above-quoted statement in the Office Action fully reflects the limitations of Claim 36. For example, Claim 36 recites the limitations that "...*for each carrier-specific delivery service offered by each respective carrier of a plurality of carriers*, determine whether the respective carrier-specific delivery service would provide delivery notification for delivering the particular parcel ...." (Emphasis added). Claim 36 further recites the limitations for "...displaying to a display device configured with the client computer device, a *simultaneous identification of each carrier-specific delivery service of each respective carrier of the plurality of carriers* that would provide the

delivery notification service." (Emphasis added).

Therefore, because the foundation asserted in the Office Action for rejecting Claim 36 does not fully reflect the limitations of Claim 36, Applicant(s) respectfully disagree that the Office Action presents a proper foundation for rejecting Claim 36 under 35 U.S.C. Section 103(a) based on a combination of Fisher and Nicholls, as those requirements are explained in MPEP §706.02(j) and MPEP §2143.

As compared to the above-recited limitations of Claim 36, it is respectfully asserted that the Office Action has not identified any passages in any of the cited references that disclose any variation in carrier-support of Proof of Delivery or any ability to determine such variation in carrier-support of Proof of Delivery. To the contrary, FIG. 4A of Nicholls, cited by the Office Action that Nicholls, appears to assume that all carriers, and all of their respective delivery services, provide Proof of Delivery.

Fig. 4A of Nicholls cited in the Office Action as a basis for rejecting Claim 36 (see, e.g., Office Action, Topic No. 23, p. 12), appears to indicate that a user may designate any one of a number of Special Services, such as, for example, Proof of Delivery, and that the Nicholls system will subsequently calculate a shipping rate. However, it is respectfully asserted that the Office Action does not cite any portion of Nicholls that indicates that there would be a different charge by different delivery services for different carriers for any Special Services indicated. Rather, contrary to the Office Action's allegations, it is respectfully asserted that Fig. 4A of Nicholls does not teach determining or identifying whether each delivery service offered by each respective carrier of a plurality of carriers would provide the requested type of delivery notification service for shipping a particular parcel, as is claimed by independent Claim 36.

The Office Action counters that assertion with the position that "... if a carrier does not provide a service, then it cannot calculate a rate for that service, therefore the calculation in Nicholls cannot be done." Office Action, Topic No. 34, p. 18.

However, it is respectfully asserted that, contrary to the holding of In re

Mahurkar, the above-stated position by the Office Action is a hindsight reflection of information gleaned from the present application, not from the disclosures of Nicholls. In particular, as noted above, it is respectfully asserted that the Office Action does not cite any portion of Nicholls to support the assertion that Nicholls would calculate a different charge by different delivery services offered by different carriers for any Special Services indicated, or otherwise determine support differentiation between different delivery services offered by different carriers as claimed by Claim 36.

Further, it is respectfully asserted that it may be possible for a carrier to provide a Special Service, such as, for example, a Proof of Delivery, without requiring any additional charge. Therefore, in the event a rate were calculated that did not include an extra charge for a Special Service indicated by a user, such as a Proof of Delivery service, such a rate, by itself, would not identify whether the carrier provided the Special Service or did not.

As compared to the apparent assumption by Nicholls that all carriers provide the “Proof of Delivery Service,” it is respectfully asserted that, for example, Claim 36 recites limitations that reflect the ability to differentiate between different carrier-specific, delivery-service-specific support for delivery notification. For example, Claim 36 recites the limitations “*...for each carrier-specific delivery service offered by each respective carrier of a plurality of carriers*, determine whether the respective carrier-specific delivery service would provide delivery notification for delivering the particular parcel ....” (Emphasis added).

The Office Action further states that “Nicholls discloses the rates are calculated for carriers with specific delivery requirements such as Proof of Delivery (See Figure 4A), but fails to disclose the specific delivery requirements includes an electronic mail delivery notification.” Office Action, Topic No. 24, p. 12. In order to compensate for the above-quoted statement that “Nicholls ... fails to disclose the specific delivery requirements includes an electronic mail delivery notification ...,” the Office Action states that “Fisher discloses a method for supplying automatic status updates using e-mail (see abstract) ...” and asserts

that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the electronic notification system, as displayed by Fisher ....” Office Action, Topic No. 24, p. 12. The Office Action further asserts that the aforementioned combination “... would have been obvious ... in order to automatically send delivery status messages over e-mail without the aid or need of a human customer service representative [citing Fisher, cols. 1 and 2].” Office Action, Topic No. 24, p. 12.

It is respectfully submitted that the above-quoted characterization by the Office Action regarding automatically sending delivery status messages over email completely misreads the claimed limitations. As opposed to the above-quoted assertions of the Office Action regarding the repeated mention of a carrier’s “specific delivery requirements,” it is respectfully submitted that Claim 36 does not recite any limitation regarding a carrier’s “delivery requirements.” Rather, Claim 36 recites, for example, “... (B) for each of said user client computer devices: (1) receiving, from the user client computer device, a request to ship a particular parcel, said request including a request that a delivery notification service be implemented in association with the shipment of the particular parcel; ....”

Further, as opposed to the above-quoted statement in the Office Action that “Fisher discloses a method for supplying automatic status updates using e-mail ...,” (Office Action, Topic No. 24, p. 12), it is respectfully submitted that the limitations claimed by Claim 36 are not directed to supplying, or in any way providing, automatic status updates using email. Rather, Claim 36 recites limitations, for example, to “...(B) for each of said user client computer devices: (1) receiving, from the user client computer device, a request to ship a particular parcel, said request including a request that a delivery notification service be implemented in association with the shipment of the particular parcel ...” and then, “...(2) in response to said request:...”

(a) for each carrier-specific delivery service offered by each respective carrier of a plurality of carriers, determine whether the respective carrier-specific delivery service would provide delivery

notification for delivering the particular parcel, and  
(b) displaying to a display device configured with the client computer device, a simultaneous identification of each carrier-specific delivery service of each respective carrier of the plurality of carriers that would provide the delivery notification service.

For the foregoing reasons and authorities, it is respectfully asserted that the combination of *Fisher* with *Nicholls*, *Kara* and *InterShipper* asserted in the Office Action is based on an improper foundation that fails to accurately reflect the claimed limitations of Claim 36. Accordingly, it is respectfully asserted that there is an insufficient foundation for rejection of Claim 36 as required under 35 U.S.C. Section 103(a), as those requirements are explained in MPEP §706.02(j) and MPEP §2143.

Yet further, for the following reasons and authorities, it is respectfully asserted that the combination of *Nicholls* and *Fisher* provide an insufficient foundation for rejection of Claim 36 as required under 35 U.S.C. Section 103(a), as those requirements are explained in MPEP §706.02(j) and MPEP §2143.

In order to compensate for the above-quoted statement that “Nicholls ... fails to disclose the specific delivery requirements includes an electronic mail delivery notification ...,” (*Office Action*, Topic No. 24, p. 12), the Office Action states that “Fisher discloses a method for supplying automatic status updates using e-mail (See abstract) ...” and asserts that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the electronic notification system, as displayed by Fisher ....” *Office Action*, Topic No. 24, p. 12. The Office Action further asserts that the aforementioned combination “... would have been obvious ... in order to automatically send delivery status messages over email without the aid or need of a human customer service representative [citing Fisher, cols. 1 and 2].” *Office Action*, Topic No. 24, p. 12.

It is respectfully submitted that there is no disclosure in *Fisher* of the *Fisher carriers* themselves providing any type of delivery notification. Rather, in *Fisher*, as further explained below, it is the *Fisher* system that interrogates a carrier's system to determine the status of a customer's respective shipment; it is

the *Fisher* system that then composes an email messages to the respective customer regarding the status of the customer's respective shipment.

*Fisher* discloses a merchant system that tracks shipment status of a customer's order sent by a particular merchant using a particular carrier to the respective ordering customer. See, e.g., *Fisher*, Abstract. According to *Fisher*, the *Fisher* system interrogates the carrier's system to determine the shipping status of the respective order. *Fisher*, col. 2, lines 12 – 18. The *Fisher* system then composes and sends an email notice to the respective ordering customer regarding their respective order shipment status. *Fisher*, col. 2, lines 12 – 18.

As compared to a system such as disclosed in *Fisher* that itself composes a shipment status email message based on a carrier-system interrogation, it is respectfully asserted that Claim 36 recites, for example, limitations for "... displaying to a display device configured with the client computer device, a simultaneous identification of each carrier-specific delivery service of each respective carrier of the plurality of carriers that would provide the delivery notification service [for delivering the particular parcel] ..." (emphasis added). That is, as compared to the *Fisher* system that itself provides shipment status, Claim 36 is directed to providing a simultaneous identification of various carriers and various delivery services that would provide delivery notification for shipping a particular parcel.

In rejecting Claim 36, the Office Action asserts that "InterShipper is an internet, online website, where internet users can enter origin, destination, package weight and dimensions and will be displayed every method possible that you can use to ship your package for all major shippers (See Internet Update Article Page 1, Paragraphs 1-3." *Office Action*, Topic No. 26, p. 13. The Office Action further asserts that "[i]t would have been obvious ... to display every method possible to ship a package, as disclosed by InterShipper, in order to find the cheapest shipping rate (See Page 1)." *Office Action*, Topic No. 26, p. 13.

The assertion of InterShipper in the rejection of Claim 36 has been carefully considered. Applicant(s) respectfully disagree with the rejection for the following reasons and authorities, and respectfully assert that Claim 36 is in

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condition for allowance.

It is respectfully asserted that InterShipper fails to disclose a simultaneous identification as claimed by Claim 36. In particular, InterShipper only states “[s]imply enter your origin, anywhere in the U.S. is OK, and destination, worldwide, along with your package weight and dimensions. The free service will return every method possible that you can use to ship your package . . . .” InterShipper, p. 1, ¶ 2.

It is respectfully submitted that InterShipper does not state that its display comprises a simultaneous identification of each carrier-specific delivery service of each respective carrier of a plurality of carriers that would provide a delivery notification service as claimed by Claim 36.

It is respectfully submitted that the author of the InterShipper article merely describes that the “[t]he free service will return every method possible that you can use to ship your package . . . .” InterShipper, p. 1, ¶ 2. In particular, the author of InterShipper did not state, and the InterShipper article does not disclose, that “every method” means each delivery service offered by each carrier. Further, it is respectfully submitted that there is no evidence that the author of the InterShipper article had any particular expertise in shipping. Therefore, it is respectfully asserted that the InterShipper’s author’s reference to “every method” may have referred to a plurality of carriers.

In view of the failure of the InterShipper article to specifically disclose the limitations of rejected independent Claim 36, it is respectfully asserted that the Office Action’s assertion of obviousness of independent 36 is a reading influenced by the disclosures of the present application and rejected independent Claim 36. Moreover, it is respectfully asserted that use by the Office Action of the disclosures of the present application and rejected independent 36 as a roadmap to support the assertions of obviousness of the rejected Claims is prohibited. Cf., e.g., In re Mahurkar Patent Litigation, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff’d*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995) (Opinion by Judge Easterbrook; “... decomposing an invention into its constituent elements, finding each element in

the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden *ex post* analysis. ... With hindsight the transistor is obvious; but devising the transistor was still a work of genius. An invention lies in a combination of elements that are themselves mundane. 'Virtually all inventions are combinations and virtually all are combinations of old elements.'.....").

Yet further, it is respectfully submitted that *InterShipper* does not disclose that its display comprises a *simultaneous* identification of each carrier-specific delivery service of each respective carrier of the plurality of carriers that would provide a delivery notification service.

Rather, it is respectfully submitted that the author of the *InterShipper* article merely describes that the "[t]he free service will return every method possible that you can use to ship your package.... ." *InterShipper*, p. 1, ¶ 2. However, the author did not state, and the *InterShipper* article does not disclose, that "every method" is displayed simultaneously. Rather, in view of the failure of the *InterShipper* article to specifically disclose the limitations of rejected independent Claim 36, it is respectfully asserted that the Office Action's assertion of obviousness of independent 36 is a reading that impermissibly uses the disclosures of the present application and rejected independent 36 as a roadmap. See *In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995).

It is therefore respectfully asserted, for the reasons described and authorities cited above, that none of *Nicholls*, *Kara*, *Fisher*, or *InterShipper*, whether considered alone or in combination with any other reference of record, anticipate, disclose, teach or suggest all of the limitations of the Claim 36 of the present application. Accordingly, it is respectfully asserted that Claim 36 is non-obvious in view of, and patentable over, the references of record. It is therefore respectfully asserted Claim 36 is in condition for allowance.

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CONCLUSION

For the above-given reasons and authorities, it is respectfully asserted that that none of cited references, or any of the other references of record, whether considered alone or in combination with each other, disclose, teach or suggest the combination of all of the limitations of the Claims, as amended, of the present application.

Therefore, in view of the foregoing amendments, and for the foregoing reasons and authorities, Applicant respectfully asserts that the invention disclosed and claimed in the present application as amended is not fairly taught by any of the references of record, taken either alone or in combination and that the application is in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and allowance of the application.

Respectfully submitted,

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